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D. REMARKS

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

Interview Summary

On February 24, 2005 at 11:00 AM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Phillips. No exhibits were shown, nor demonstrations conducted.

With regard to the claims, the prior art cited by the Examiner in a 102(e) rejection against claims 1-6, 8-13, 15-19, 21-32, 34-36, and 38-40 is Friedman (US Patent Number 6,714,791).

Applicants' representative and the Examiner discussed the following items:

(1) With regard to claim 1, Applicants proposed an amendment to clarify the scope of "device information." In particular, Applicants proposed an amendment to clarify that device information comprises at least one from among "a power level of said particular device, a signal strength available to said particular device, and a cost for a user at said particular device to participate in said messaging session." The Examiner stated that the clarification of the scope of device information distinguishes the claim over the previously cited section of Friedman, but stated that an additional search of Friedman would be required before the Examiner would remove the rejection.

(2) With regard to claim 30, Applicants proposed an amendment to clarify the scope of "device information" in the same way as proposed in claim 1. In addition, Applicants proposed an amendment to add the element of "comparing said device information with at least one performance threshold set by said particular user" and then limiting the outputting element of claim 30 as "responsive to said device information exceeding said performance threshold." The Examiner stated that the Amendments to claim 30 would also distinguish the claim from the previously cited section of Friedman, but that an additional search would be required.

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In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

Claim Objections

The Examiner objects to the specification because of the following informalities: "The text on page 1, line 10 through page 2, line 2 should be updated with the current status of the cited applications." [Office Action, p. 2] Applicants note that the specification is amended above to add the current patent application serial number of each co-pending application and therefore Applicants respectfully request removal of the objection to the specification.

35 USC § 102(e)

Claims 1-6, 8-13, 15-19, 21-32, 34-36, and 38-40

Claims 1-6, 8-13, 15-19, 21-32, 34-36, and 38-40 stand rejected under 35 U.S.C. §102(e) as being anticipated by Friedman (US Patent Number 6,714,791). [Office Action, p. 2] The rejection is respectfully traversed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksma*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because Friedman does not teach each and every element of the claims 1-6, 8-13, 15-19, 21-32, 34-36, and 38-40 or enable each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

<u>Claims 1, 8, and 15</u>

Independent method claim 1, which is representative of independent system claim 8 and independent computer program product claim 15, with regard to similarly recited subject matter and rejection, reads as follows:

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1. (Currently Amended) A method for controlling distribution of device information to a plurality of users participating in a messaging session, said method comprising the steps of:

receiving device information for a particular device utilized by a particular user participating in a messaging session, wherein said device information comprises at least one from among a power level of said particular device, a signal strength available to said particular device, and a cost for said particular user at said particular device to participate in said messaging session;

filtering said device information according to authorization preferences; and

distributing said filtered device information to at least one other user participating in said messaging session, such that said at least one other user is enabled to monitor said particular device utilized by said particular user during said messaging session.

Applicants respectfully assert that Friedman does not teach, expressly or inherently, or enable the invention of amended claims 1, 8, and 15 because Friedman does not teach or enable receiving device information for a particular device utilized by a particular user participating in a messaging session, wherein said device information comprises at least one from among a power level of said particular device, a signal strength available to said particular device, and a cost for said particular user at said particular device to participate in said messaging session. Because Friedman does not teach or enable the invention of amended claims 1, 8, and 15, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

In particular, with respect to claims 1, 8, and 15, the Examiner cites Friedman as teaching "receiving device information for a particular device (1050, 1051, or 1052) utilized by a particular user (A,B, or C) participating in a messaging session" at col. 12, lines 60-67 and col. 13, lines 1-9. [Office Action, p. 3] Applicants have amended the claims to clarify that the present invention is not taught by or enabled by Friedman and therefore traverse the amended elements in view of Friedman.

First, col. 12, lines 60-67 and col. 13, lines 1-9 of Friedman, as cited by the Examiner, reads:

"Referring to FIG. 10, in one embodiment of the invention, a location tracking module 1010 executed on the portal server 110 will monitor the location of each portal device/user 1050-1052 on the system and transmit the portal device/user location 1020-1022 respectively, in response to certain events. For example,

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"User A" may configure his/her portal device 1050 and/or the portal server 110 to transmit positional data whenever User A sends a message to other users. User A may also specify a subset of users who should receive positional data when User A transmits a message (e.g. via a "buddy list"). Moreover, User A may specify the types of positional data that users within the subset should receive. For example, User A may specify that "User B" should only receive a measurement of the distance between User A and User B; whereas User C should receive User A's precise location (e.g. 156 University Aye, Palo Alto, Calif.)."

Thus, Friedman teaches that a wireless device may include a location tracking module that independently monitors the position location of a device and that a server may monitor that positional data and transmit the data to other buddies during an instant messaging session. Freidman does not, however, teach or enable monitoring device information of a device used by a user participating in a messaging session from among the power level of the device, a signal strength available to the device, or a cost for a user at the device to participate in the messaging session.

Next, in contrast, the present invention teaches that device information received by a system that filters and distributes the device information includes at least one of a power level of a device, a signal strength available to the device, or a cost for the user at the device to participate in the messaging session using the device. In particular, page 9, lines 8-12 and page 15, lines 5-16 of the specification teach receiving device information which may include a power level of a particular device utilized by a particular user, a signal strength of a particular device utilized by a particular user, and a cost for participation in the messaging session for a user at a device.

Therefore, Applicants respectfully assert that because Friedman does not teach or enable receiving a power level of a particular device, a signal strength of a particular device, or a cost for a particular user at the particular device to participate in the messaging session using the device, Friedman does not teach at least one element of claims 1, 8, and 15. Because Friedman does not teach, expressly or inherently, or enable at least one element of claims 1, 8, and 15, Friedman does not anticipate claims 1, 8, and 15 and the claims should be allowed.

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Claims 2-6, 9-13, 16-19

Because Friedman does not anticipate claims 1, 8 and 15, at least by virtue of their dependency on claims 1, 8, and 15, Friedman does not teach or enable the features of dependent claims 2-6, 9-13, and 16-19 under 35 U.S.C. §102 (e). Because anticipation is not established for claims 2-6, 9-13, and 16-19, Applicants respectfully request allowance of claims 2-6, 9-13, and 16-19.

In addition, with regard to claims 4, 11, and 17, Applicants amend claim 4 to teach receiving said device information only when said device information reaches a threshold indicating a potential disconnection by said particular device from said messaging session. Friedman does not teach receiving the device information only when the device information reaches a threshold indicating a potential disconnection by the particular device from the messaging session based on device usage and accessibility thresholds being reached. The specification of the present invention teaches limiting the distribution of device information until the information reaches potential disconnection thresholds at page 21, line 32 through page 22, line 11 and page 22 line 32 through page 23 line 6. Therefore, because Friedman does not teach receiving said device information only when said device information reaches a threshold indicating a potential disconnection by said particular device from said messaging session, Friedman does not teach claims 4, 11, and 17, expressly or inherently, and therefore the claims should be allowed.

Claims 21, 24, and 27

Independent method claim 21, which is representative of independent system claim 24 and independent computer program product claim 27, with regard to similarly recited subject matter and rejection, reads as follows:

21. (Currently Amended) A method for participating in a messaging session, said method comprising the steps of:
determining device information for a particular device utilized by a particular user to participate in a messaging session, wherein said device information comprises at least one from among a power level of said particular device, a signal strength available to said particular device, and a cost for said

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particular user at said particular device to participate in said messaging session;
and

transmitting said [current] device information for distribution to at least
one other user participating in said messaging session, such that said device
information for said particular device is communicated within said messaging
session.

Applicants respectfully assert that Friedman does not teach, expressly or inherently, or
enable the invention of amended claims 21, 24, and 27 because Friedman does not teach or
enable determining device information for a particular device utilized by a particular user to
participate in a messaging session, wherein said device information comprises at least one from
among a power level of said particular device, a signal strength available to said particular
device, and a cost for said particular user at said particular device to participate in said
messaging session. Because Friedman does not teach or enable the invention of amended claims
21, 24, and 27, Applicants respectfully request withdrawal of the rejection and allowance of the
claims.

In particular, with respect to claims 21, 24, and 27, the Examiner cites Friedman as
teaching "determining device information for a particular device (1050, 1051, or 1052) utilized
by a particular user (A,B, or C) participating in a messaging session" at col. 12, lines 60-67 and
col. 13, lines 1-9. [Office Action, p. 4] Applicants have amended the claims to clarify that the
present invention is not taught by or enabled by Friedman and therefore traverse the amended
elements in view of Friedman.

In particular, the Examiner cites the same portion of Friedman (Col. 12, lines 60-67 and
col. 13, lines 1-9) as teaching claims 1, 8, and 15 and claims 21, 24, and 27. As asserted with
reference to claims 1, 8, and 15, Friedman does not teach or enable receiving device information
for a particular device used in a messaging session where the device information includes a
power level of the device, a signal strength available to the device, or a cost for a user using the
device to participate in the messaging session. Thus, Applicants also assert that Friedman does
not teach or enable determining device information for a particular device used in a messaging
session where the device information includes a power level of the device, a signal strength
available to the device, or a cost for a user using the device to participate in the messaging

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session. Therefore, Applicants respectfully assert that because Friedman does not teach or enable <u>determining a power level of a particular device, a signal strength of a particular device, or a cost for a particular user at the particular device to participate in the messaging session using the device,</u> Friedman does not teach at least one element of claims 21, 24, and 27. Because Friedman does not teach, expressly or inherently, or enable at least one element of claims 21, 24, and 27, Friedman does not anticipate claims 21, 24, and 27 and the claims should be allowed.

<u>Claims 22, 23, 25, 26, 28, and 29</u>

Because Friedman does not anticipate claims 21, 24, and 27, at least by virtue of their dependency on claims 21, 24, and 27, Friedman does not teach or enable the features of dependent claims 22, 23, 25, 26, 28, and 29under 35 U.S.C. §102 (e). Because anticipation is not established for claims 22, 23, 25, 26, 28, and 29, Applicants respectfully request allowance of claims 22, 23, 25, 26, 28, and 29.

In addition, with regards to claims 22, 25, and 28, Applicants note that these claims are amended to include new limitations on "transmitting said device information". In particular, claims 22, 25, and 28 now include <u>comparing said device information with a threshold indicating potential disconnection of said particular device from said messaging session</u> and <u>only transmitting said device information if said device information exceeds said threshold.</u> The specification of the present invention teaches limiting the transmission of device information until the information reaches potential disconnection thresholds at page 21, line 32 through page 22, line 11 and page 22 line 32 through page 23 line 6. Friedman does not teach transmitting device information only when the device information reaches a threshold indicating a potential disconnection by the particular device from the messaging session based on device usage and accessibility thresholds being reached. Therefore, because Friedman does not teach <u>comparing said device information with a threshold indicating potential disconnection of said particular device from said messaging session</u> and <u>only transmitting said device information if said device information exceeds said threshold,</u> Friedman does not teach amended claims 22, 25, and 28, expressly or inherently, and therefore the claims should be allowed.

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Claims 30, 34, and 38

Independent method claim 30, which is representative of independent system claim 34

and independent computer program product claim 38, with regard to similarly recited subject

matter and rejection, reads as follows:

30.   (Currently Amended) A method for monitoring devices utilized within a
messaging session, said method comprising the steps of:
         receiving device information for at least one other device utilized by at
least one other user participating in a messaging session at a particular device
utilized by a particular user participating in said messaging session, wherein said
device information comprises at least one indicator of a potential disconnection
from among a power level of said particular device, a signal strength available to
said particular device, and a cost for said particular user at said particular device
to participate in said messaging session;
         comparing said device information with at least one performance
threshold set by said particular user; and
         responsive to said device information exceeding said performance
threshold, outputting said device information through said particular device
according to device output preferences, such that said particular device is enabled
to monitor said device information for said at least one other device utilized in
said messaging session.

Applicants respectfully assert that Friedman does not teach, expressly or inherently, or

enable the invention of amended claims 30, 34, and 38 because Friedman does not teach or

enable receiving device information for at least one other device utilized by at least one other

user participating in a messaging session at a particular device utilized by a particular user

participating in said messaging session, wherein said device information comprises at least one

indicator of a potential disconnection from among a power level of said particular device, a

signal strength available to said particular device, and a cost for said particular user at said

particular device to participate in said messaging session, comparing said device information

with at least one performance threshold set by said particular user or outputting said device

information through said particular device according to device output preferences, responsive to

said device information exceeding said performance threshold. Because Friedman does not teach

or enable the invention of amended claims 30, 34, and 38, Applicants respectfully request

withdrawal of the rejection and allowance of the claims.

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In particular, with respect to claims 30, 34, and 38, the Examiner cites Friedman as teaching "receiving device information for at least one other device utilized by at least one other user (A,B, or C) participating in a messaging session at a particular device utilized by a particular user participating in said messaging session; and outputting said device information through said particular device according to device output preferences, such that said particular device is enabled to monitor said device information for said at least one other device utilized in said messaging session" at col. 12, lines 60-67 and col. 13, lines 1-9. [Office Action, p. 4] Applicants have amended the claims to clarify that the present invention is not taught by or enabled by Friedman and therefore traverse the amended elements in view of Friedman.

First, the Examiner cites the same portion of Friedman (Col. 12, lines 60-67 and col. 13, lines 1-9) as teaching claims 1, 8, and 15 and claims 30, 34, and 38. As asserted with reference to claims 1, 8, and 15, Friedman does not teach or enable receiving device information for a particular device used in a messaging session where the device information includes a power level of the device, a signal strength available to the device, or a cost for a user using the device to participate in the messaging session. Thus, Applicants also assert with reference to claims 30, 34, and 38 that Friedman does not teach or enable receiving device information for at least one other device utilized by at least one other user participating in a messaging session at a particular device, where the device information includes an indicator of a potential disconnection such as a power level of the device, a signal strength available to the device, or a cost for a user using the device to participate in the messaging session. As previously cited, page 9, lines 8-12 and page 15, lines 5-16 of the specification teach receiving device information which may include a power level of a particular device utilized by a particular user, a signal strength of a particular device utilized by a particular user, and a cost for participation in the messaging session for a user at a device. Therefore, Applicants respectfully assert that because Friedman does not teach or enable receiving device information for at least one other device utilized by at least one other user participating in a messaging session at a particular device utilized by a particular user participating in said messaging session, wherein said device information comprises at least one indicator of a potential disconnection from among a power level of said particular device, a signal strength available to said particular device, and a cost for said particular user at said

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particular device to participate in said messaging session, Friedman does not teach at least one element of claims 30, 34, and 38. Because Friedman does not teach, expressly or inherently, or enable at least one element of claims 30, 34, and 38, Friedman does not anticipate claims 30, 34, and 38 and the claims should be allowed.

Second, Applicants note that claims 30, 34 and 38 are amended for purposes of clarification, to indicate that the device information including at least one indicator of a potential disconnection is compared with a threshold, and that device information is only output at another user's device if the device information exceeds a threshold. Applicants note that Friedman does not teach filtering of device information based on whether device information meets a threshold where the device information is at least one indicator of a potential disconnection such as a power level, a signal strength, or a cost for user participation in the messaging session. Further, Applicants note that the specification teaches comparing device information with a threshold and then only enabling output of device information at another user's device if the device information exceeds a threshold at page 21, line 32 through page 22, line 11 and page 22 line 32 through page 23 line 6, for example. Therefore, Applicants respectfully assert that because Friedman does not teach or enable comparing said device information with at least one performance threshold set by said particular user or outputting said device information through said particular device according to device output preferences, responsive to said device information exceeding said performance threshold, Friedman does not teach at least one element of claims 30, 34, and 38. Because Friedman does not teach, expressly or inherently, or enable at least one element of claims 30, 34, and 38, Friedman does not anticipate claims 30, 34, and 38 and the claims should be allowed.

Claims 31, 32, 35, 36, 39, and 40

Because Friedman does not anticipate claims 30, 34, and 38, at least by virtue of their dependency on claims 30, 34, and 38, Friedman does not teach or enable the features of dependent claims 31, 32, 35, 36, 39, and 40 under 35 U.S.C. § 102 (e). Because anticipation is not established for claims 31, 32, 35, 36, 39, and 40, Applicants respectfully request allowance of claims 31, 32, 35, 36, 39, and 40.

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35 USC § 103(a)

Claims 7, 14, 20, 33, 37, and 41

The Office Action rejects claims 7, 14, 20, 33, 37, and 41 under 35 U.S.C. §103(a) as being allegedly unpatentable over Friedman. [Office Action, p. 6] The rejection is respectfully traversed.

Claims 7, 14, and 20

Because Friedman does not anticipate claims 1, 8, and 15, at least by virtue of their dependency on claims 1, 8, and 15, the combination of claims 1, 8, and 15 with dependent claims 7, 14, and 20 does not satisfy the requirements for obviousness under 35 U.S.C. 103(a). Because obviousness is not established for claims 7, 14, and 20, Applicants respectfully request allowance of claims 7, 14, and 20.

Claims 33, 37, and 41

Because Friedman does not anticipate claims 30, 34, and 38, at least by virtue of their dependency on claims 30, 34, and 38, the combination of claims 30, 34, and 38 with dependent claims 33, 37, and 41 does not satisfy the requirements for obviousness under 35 U.S.C. 103(a). Because obviousness is not established for claims 33, 37, and 41, Applicants respectfully request allowance of claims 33, 37, and 41.

37 CFR 1.131 Affidavit

Applicants traversed the rejections of claims 1-41 in view of the amendments made to the claims to overcome rejections based on Friedman. In addition, Applicants file an affidavit under 37 CFR 1.131 to further overcome rejections based on Friedman. In particular, in the rejection under 35 U.S.C. 102, the Examiner cites Friedman as prior art under 102(e). Section (a) of 37 CFR 1.131 requires that when any claim of an application is rejected, the inventor of the subject matter of the rejected claim or the party qualified under sections 1.42, 1.43 or 1.47, may submit

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an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference on which the rejection is based.

Applicants file an affidavit under 37 CFR 1.131 signed by a legal representative with power of attorney from both the inventors and assignee that states facts that show that prior to February 23, 2001, the inventors had completed the conception of the subject matter of at least rejected claims 1-6, 8-13, 15-19, 21-32, 34-36, and 39-40.

In conclusion, because Friedman can no longer be used as prior art under 102, Friedman also cannot be used as prior art under 103. Applicants respectfully request allowance of claims 1-6, 8-13, 15-19, 21-32, 34-36, and 39-40 which are rejected as anticipated Friedman under 102(e) and of claims 7, 14, 20, 33, 37, and 41 which are rejected as obvious in view of Friedman under 103(a).

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Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,
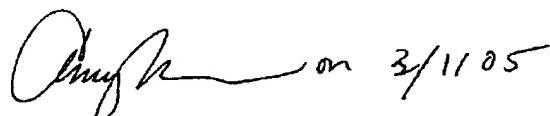
on 3/11/05

Amy J. Pattillo
Attorney for Applicants
Reg. No 46,983
P.O. Box 161327
Austin, Tx 78716
512.402.9820 *vox*
512.306.0417 *fax*

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